

REMARKS

Applicant respectfully requests reconsideration and continued examination of this application in view of the amendments and following remarks. Claims 1-8, 10, and 12-22 are pending in this application.

Applicant is grateful for the allowance of claims 13 and 19.

1. Status of the Claims

Claims 1, 6 and 14 have been amended. Claims 21 and 22 are new. Claims 9 and 11 have been canceled. Claim 6 has been amended to include the subject matter of claim 11. Support for the amendments to claims 1 and 14 and the new claims can be found at ¶¶ 4, 5, 26, 27, 34, 39 and FIG. 10 of the published application (1:25-31, 7:23-32 and 9:16-26 of the filed application). Claims 1 and 14 are the only independent claims.

2. Prior Art Rejections

Claims 1-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,987,402 to Nykerk et al ("Nykerk"). Claims 14-18 were rejected under 35 U.S.C. 103(a) as being obvious over Nykerk in view of Thacker (U.S. Patent No. 6,359,564). In an email dated June 28, 2007, the Examiner clarified that claims 13 and 19 were allowable over the prior art, but were objected to for being dependent on a rejected based claim. Claim 20 was not rejected over the prior art. In fact, the Office Action indicates "Neither Nykerk nor Thacker disclose, teach or suggest" the limitation of claim 20.

3. Independent Claims 1 and 14 Are Patentable Over The Prior Art For Two Reasons

Independent claim 1 requires that a detector device be mounted in at least close proximity to an at least substantially transparent door of a building. Independent claim 14 requires mounting a device to a building. Nykerk discloses a car alarm. Nykerk

does not teach, disclose or suggest a device mounted to a building or mounted in proximity to an at least substantially transparent door of a building.

Thacker discloses an occupancy status indicator for a cubicle. Cubicles do not have doors, never mind substantially transparent doors. The subject matter of occupancy status indicators does not suggest an at least substantially transparent door because occupancy status indicators are generally used with opaque doors as in photography dark rooms and bathrooms. Therefore, the invention, requiring a detection device mounted to a building or mounted in at least close proximity to a substantially transparent door of a building as claimed, is not taught or suggested by any combination of the references. Consequently, independent claims 1 and 14 are patentable over Nykerk and Thacker and all of the pending claims are allowable for these reasons alone.

The independent claims are also patentable for a second reason. In responding to Applicant's arguments in the Amendment filed February 19, 2007, Examiner indicated in the Office Action of May 14, 2007, that the claims were not allowable because the "claims do[] not recite that the alarm is to warn a person of the impending danger [of a collision between a person and the substantially transparent door." The claims have been amended to recite "warning a person approaching a substantially transparent door ... so that the person can avoid colliding with the door." Neither Nykerk, nor Thacker in any way disclose, teach or suggest the invention as claimed. Therefore the independent claims are patentable.

4. Claims 10 and 18 Are Patentable Independently of Claims 1 and 14

Claims 10 and 18 both further require that a visually attractive shape having a pouch be removably mounted to an at least substantially transparent door and that the detector device be placed in the pouch. As Nykerk does not disclose an at least substantially transparent door and Thacker does not disclose a door, Nykerk and Thacker both fail to disclose, teach or suggest this limitation. In addition, they both fail to disclose a visually attractive shape for passively warning a person of the door. Moreover, both Nykerk and Thacker do not suggest such a visually attractive shape

because such a shape does not provide the benefit of indicating an at least substantially transparent door in Nykerk and Thacker. Therefore, claims 10 and 18 are patentable over Nykerk and Thacker.

5. Claims 21 and 22 Are Patentable Independently of Claims 1, 10, 14 and 18

Claims 21 and 22 require the device or detector to be mounted to a screen door. Neither Nykerk nor Thacker disclose screen doors. Additionally, Nykerk and Thacker do not suggest mounting a device or detector to a screen door because cars and cubicles do not have screen doors. Thus claims 21 and 22 are patentable.

6. Claim 20 Is Patentable

Claim 20 was rejected under 35 U.S.C. § 101 as being non-patentable subject matter "because a person's awareness of the presence of the door is not discreet and tangible." Claim 20 was also rejected under 35 U.S.C. § 112 because the specification "fails to disclose how a person's awareness would be detected." Claim 20 was not rejected over the prior art. Applicant traverses the rejections of claim 20.

MPEP §2106.II indicates that when evaluating a claim for patentable subject matter

every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.

(emphasis added). Claim 20 depends on claim 14. Thus, the determination of whether claim 20 is patentable subject matter must include the limitations of claim 14. The invention of claim 20 is a method for warning a person approaching a door. The invention includes "mounting a device in at least close proximity to an at least substantially transparent door," "detecting the person approaching the door, wherein the person is unaware of the door" and "automatically generating ... the audible warning ... so that the person can avoid colliding with the door."

To be patentable subject matter a method must produce a "useful, concrete and tangible result." See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50

U.S.P.Q.2d 1447 (Fed. Cir. 1999) (process of adding information about the recipient of a call to message records used in billing long-distance calls produced a “useful, concrete and tangible result” and was thus statutory subject matter). The result of the invention of claim 20 is useful, concrete and tangible in that a warning is emitted that permits a person to avoid colliding with a substantially transparent door, thereby avoiding or lessening injury to the person and damage to the door. Thus, claim 20 produces a useful, concrete and tangible result.

In addition, claim 20 is a process claim, one of the enumerated categories of inventions under 35 U.S.C. 101. Furthermore, the claimed invention of claim 20 is not an abstract idea, law of nature, or natural phenomenon. Thus, claim 20 is patentable subject matter.

Furthermore, the patentable subject matter rejection of claim 20 is in tension with both *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 68 USPQ2d 1154 (Fed. Cir. 2003) and *Rapoport v. Dement*, 254 F.3d 1053 (Fed. Cir. 2001). In *Rexall*, the Federal Circuit construed “A method of treating or preventing macrocytic-megaloblastic anemia ... which comprise administering a daily oral dosage of a vitamin to a human in need thereof.” *Rexall*, 342 F.3d at 1330. It held that the limitation “to a human in need thereof” requires that the person taking the vitamin preparation recognize and appreciate the need to treat or prevent macrocytic-megaloblastic anemia. *Id.* at 1334. In other words, “administering the claimed vitamins ... for some purpose other than treating or preventing macrocytic-megaloblastic anemia is not practicing the claim.” *Id.* In *Rapoport*, “A method for treatment of sleep apneas comprising administering [a pharmaceutical] ... to a patient in need thereof” was construed as requiring the method to be practiced with the intent to achieve the treatment of sleep apnea. *Rapoport*, 254 F.3d at 1061. Thus, in both *Rapoport* and *Rexall*, the Federal Circuit expressly read an intent requirement into the claimed method invention. In neither case, was the Federal Circuit concerned about patentable subject matter (35 U.S.C. § 101).

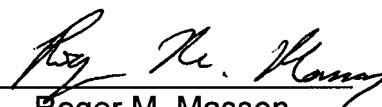
Nor was the Federal Circuit concerned about written description (35 U.S.C. § 112). In particular, in both cases, the Federal Circuit addressed whether the required intent was present. At no time, did the Federal Circuit refer to a disclosure in the

disputed patents of how the intent would be determined. Thus, the rejections of claim 20 conflict with binding Federal Circuit precedent. The written description requirement for claim 20 is fulfilled because a person unaware of a door and approaching the door is disclosed. There is simply no additional written description requirement that the application disclose how to determine whether a person is unaware of a door. Consequently, the rejections of claim 20 should be withdrawn.

CONCLUSION

In view of the foregoing, all of the rejections have been overcome and claims 1-8, 10, and 12-22 are allowable. An early indication of allowance is solicited.

Respectfully submitted,

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